

### **DETAILED ACTION**

1. Claims 1-20 have been presented for examination.

#### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

#### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 17 march 2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

#### ***Claim Objections***

4. Claim 20 is objected to because it recites "storing a 17 computer program element as claimed in claim 19." It is unclear if the 17 is a typo, a reference to a figure, or the Applicant's attempt at what would appear to be an improper multiple dependent claim. For the sake of examination the Examiner will interpret claim 20 as "storing a computer program element as claimed in claim 19." Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "substantially" in claims 1-20 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not

provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. See MPEP § 2173.05(b).

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 18 and 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. As per claim 18, page 4, lines 3-6 of the Specification of the instant application describes that the present invention can be implemented as computer program code, thereby rendering the “means for” language in claim 18 as computer software. *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), decided that

the “broadest reasonable interpretation” that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.

See MPEP § 2181 also. Therefore, giving the claims their broadest reasonable interpretation, while keeping the structure disclosed in the specification in my mind, one of ordinary skill in the art would construe claim 18 as representing a computer program *per se*.

10. As per claim 19, merely claimed as a computer program representing a computer listing *per se*, that is, descriptions or expressions of such a program and that is, descriptive material *per se*, non-functional descriptive material, and is not statutory because it is not a physical “thing” nor a statutory process, as there are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer

program and other claimed aspects of the invention which permit the computer program's functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the program itself is not a process, without the computer-readable medium needed to realize the computer program's functionality. In contrast, a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program's functionality to be realized, and is thus statutory. **Warmerdam**, 33 F.3d at 1361, 31 USPQ2d at 1760. **In re Sarkar**, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). See MPEP § 2106(IV)(B)(1)(a).

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1, 2, 9, and 14-20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0023642 A1 to Tezuka, hereinafter Tezuka.

13. As per claim 1, Tezuka teaches a data processing method comprising the steps of receiving a redeemable token containing substantially irrefutable evidence of network access having been granted to a wireless communication device by a base station (Figures 2 [block 16], 4 [block 146], paragraphs 0023-0025, 0027, i.e. a wireless access point issuing a certificate to a wireless terminal, so that the wireless terminal can access LANs); and

redeeming the token by associating at least a portion of a resource with the grant of the network access (paragraphs 0036, 0037, 0039, i.e. authenticating the client based on user data, user name, password, authentication condition, IP address, certificate, etc.).

14. Regarding claim 2, Tezuka teaches the step of associating comprises the step of allocating the portion of the resource to, or for consumption by, an identifiable party (paragraph 0022, i.e. authenticating the client for access to the LAN).

15. As per claim 9, Tezuka teaches a data processing method comprising the step of outputting a redeemable token containing substantially irrefutable evidence of network access having been granted to a wireless communication device by a base station (Figures 2 [block 16], 4 [block 146], paragraphs 0023-0025, 0027, i.e. a wireless access point issuing a certificate to a wireless terminal, so that the wireless terminal can access LANs).

16. As per claim 14, Tezuka teaches a data processing method comprising the steps of outputting data from which a redeemable token representing substantially irrefutable evidence (Figures 2 [block 16], 4 [block 146], paragraphs 0023-0025, 0027, i.e. a wireless access point issuing a certificate to a wireless terminal, so that the wireless terminal can access LANs) of network access having been granted by a base station to a wireless communication device can be derived (paragraphs 0036, 0037, 0039, i.e. client providing user data, user name, password, authentication condition, IP address, etc. to be issued a certificate as described in the cited section above).

17. Regarding claim 15, Tezuka teaches the step of outputting comprises the step of outputting unique identification data (paragraphs 0036, 0037, 0039, i.e. client providing user data, user name, password, authentication condition, IP address, etc.).

18. With regards to claim 16, Tezuka teaches outputting unique identification data comprises the step of outputting at least a portion of predetermined address data used by the wireless communication device in communicating with a base station (paragraph 0036, i.e. IP address).

19. Regarding claim 17, Tezuka teaches outputting comprises the step of outputting data comprising an authenticated digital signature providing substantially irrebuttable evidence of the identity of the wireless communication device (paragraphs 0036, 0037, 0039).

20. As per claim 18, Tezuka teaches a system comprising means to implement a method as claimed in claim 1 (Figure 3, claim 5).

21. As per claim 19, Tezuka teaches a computer program element comprising computer program code means to implement a system or method as claimed in claim 1 (paragraph 0009, i.e. implementing the invention on computers such as PCs, routers, etc.).

22. As per claim 20, Tezuka teaches a computer program product comprising computer

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readable storage storing a computer program element as claimed in claim 19 (paragraph 0009, i.e. implementing the invention on computers such as PCs, routers, etc.).

***Claim Rejections - 35 USC § 103***

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 3-8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tezuka in view of U.S. Patent Application Publication No. 2005/0286489 A1 to Shin et al., hereinafter Shin.

25. With regards to claim 3, Tezuka does not teach allocating at least a portion of a resource comprises forwarding data, to a third party institution, representing a transfer of the portion of the resource to the identifiable third party.

26. Shin teaches allocating at least a portion of a resource comprises forwarding data, to a third party institution, representing a transfer of the portion of the resource to the identifiable third party (Figure 1 [blocks 42, 48], 3 [blocks 310, 340], 4, paragraphs 0031 0033, 0038, i.e. forwarding authentication information to the access point manager).

27. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allocate at least a portion of a resource comprises forwarding data, to a third party institution, representing a transfer of the portion of the resource to the identifiable third party, since Shin states in the abstract that forwarding data to a third party institution allows the wireless terminal to continuously access the network through the access points of the same

subnet as well as different subnets without re-authentication, thereby achieving mobility and processing charging.

28. Concerning claim 4, Tezuka teaches the identifiable third party is an owner of the base station (Figure 1 [blocks 42, 48], 3 [blocks 310, 340], 4, paragraphs 0031 0033, 0038).

29. Regarding claims 5, 6, and 10, Tezuka does not teach receiving from the wireless communication device unique identification data associated therewith and deriving the substantially irrefutable evidence from the received data.

30. Shin teaches receiving from the wireless communication device unique identification data associated therewith (paragraph 0016, 0033, i.e. adding information of the wireless terminal to an authentication request message) and deriving the substantially irrefutable evidence from the received data (paragraph 0034, authenticating using MD-5, TLS, SRP, and OTP).

31. It would have been obvious to one of ordinary skill in the art at the time the invention was made to receive receiving from the wireless communication device unique identification data associated therewith and derive the substantially irrefutable evidence from the received data, since Shin states in the abstract that providing an irrefutable token to a wireless terminal based on identification data of the wireless terminal allows the wireless terminal to continuously access the network through the access points of the same subnet as well as different subnets without re-authentication, thereby achieving mobility and processing charging.

32. With regards to claims 7 and 11, Shin teaches receiving comprises the step of receiving at

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least a part of predetermined address data used by the wireless communication device in communicating with the base station (Figure 5a [client-MAC address], paragraph 0044).

33. Concerning claims 8 and 12, Shin teaches the predetermined address data is derived from at least part of a MAC address used by the wireless communication device (Figure 5a [client-MAC address], paragraph 0044).

34. With regards to claim 13, Shin teaches the step of receiving from the wireless communication device data associated therewith comprises the step of receiving authenticated digital data providing evidence of an substantially irrefutable association with the wireless communication device or an owner thereof (paragraph 0016, 0033, 0034).

### ***Conclusion***

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

36. The following patents are cited to further show the state of the art with respect to access points issuing tokens, such as:

United States Patent Application Publication No. 2003/0014315 A1 to Jaalinoja et al. , which is cited to show using tokens on a cellular network to gain access to various goods and services.

United States Patent Application Publication No. 2003/0140256 A1 to Hauenstein et al., which is cited to show tokens being issued from an access point that indicate prepayment for goods and services.



United States Patent No. 6,112,078 to Sormunen et al., which is cited to show authenticating a user via an access point using paging or a short message service.

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian LaForgia whose telephone number is (571)272-3792.

The examiner can normally be reached on Monday thru Thursday 7-5.

38. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L. Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

39. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christian LaForgia/  
Primary Examiner, Art Unit 2139

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